Attorney Docket No.: **ISPH-0614**
Inventors: **Wu et al.**
Serial No.: **09/992,738**
Filing Date: **November 14, 2001**

REMARKS

Claims 1-42 are pending in this application. Claims 1-42 have been subjected to a restriction requirement. No new matter has been added by this amendment. Reconsideration is respectfully requested in view of the following remarks.

Restriction to one of the following inventions has been required by the Examiner under 35 U.S.C. 121:

Group I, claims 1-19, drawn to a human RNase H1 polypeptide comprising one or more mutants from the wild type wherein the mutant version retains detectable cleavage activity, classified in class 435, subclass 199;

Group II, claims 20-21, drawn to a human RNase H1 polypeptide comprising one or more mutants from the wild type wherein the mutant version retains no detectable cleavage activity, classified in class 435, subclass 199;

Group III, claims 22-29, drawn to a method of enhancing inhibition of expression of a selected protein by an antisense oligonucleotide classified in class 435, subclass 91.1;

Group IV, claims 30-33, drawn to a method of eliciting cleavage of a selected cellular RNA classified in class 435, subclass 91.1;

Group V, claims 34-42, drawn to a method of screening oligonucleotides to identify an effective antisense oligonucleotide, classified in class 435, subclass 91.1.

The Examiner suggests that group are distinct each from the other, Groups I and II are suggested to be drawn to mutations, one that has detectable activity and one that does not. Groups I and (III-V) are suggested to be related as product and process of use. The Examiner suggests that because the inventions are distinct for the recited reasons, they have acquired a separate status in the art, as shown by their different classification and divergent subject matter. Applicants respectfully traverse this restriction requirement.

The MPEP §803 is quite clear, for a proper restriction requirement, it must be shown (1) that the inventions are independent or distinct AND (2) that there would be a serious burden on the Examiner if the restriction is not required. MPEP 802.01 defines "distinct" to mean that the "two or more subjects as disclosed are related, for example, as combination and part (subcombination) thereof, process and apparatus for its practice, process and product made there, etc., but are capable of separate manufacture, use, or sale, as claimed, AND ARE PATENTABLE (novel and unobvious) OVER EACH OTHER."

As acknowledged by the Examiner, all of the identified Groups are related to a human Rnase H polypeptide. Thus, Applicants respectfully disagree with the Examiner's suggestion that the Groups are distinct as being novel and unobvious over each other as required by MPEP § 802.01.

Further, a search relating to human RNase H would identify prior art relevant to all of the claims of the instant application and would not be overly burdensome to the Examiner. Accordingly, the instant Restriction Requirement meets neither of the criteria as set forth by MPEP §803 to be proper.

Under MPEP §803, if search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions. Accordingly, reconsideration and withdrawal of the election requirement of the sequences recited in Groups I through V is respectfully requested.

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However, in an earnest effort to be completely responsive, Applicants hereby elect to prosecute Group I, with traverse.

Respectfully submitted,

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Date: September 22, 2003

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